Remarks/Arguments:

These remarks are presented in response to the Office Action dated August 8, 2007. Applicants respectfully request reconsideration of the application. Claims 1-8 are pending in the application, and stand rejected at present.

Claims 1-8 are rejected under 35 U.S.C.103(a) as being unpatentable over Parlar et al. (USP 6,631,764) in view of Fischer et al. (USP 3,753,903). Applicants point out that Fischer et al. teaches choice of emulsifier is extremely critical, both with regard to the formation of the wax dispersion and to the stability of the ultimate fluid (see column 6 lines 21 - 23). Fischer discloses only fluids which are emulsions and defines wax dispersions as wax particles in aqueous salt solutions, throughout the specification. At column 2, lines 26 – 31, Fischer discloses, "the well completion and workover fluids of this invention comprise dispersions of finely divided solid wax particles and finely divided solid particles of a water insoluble, acid-soluble inorganic material in an aqueous salt solution containing especially selected emulsifiers." Thus, Fischer only teaches wax-in-brine emulsions. Fischer is completely silent as to forming a brine-in-oil emulsion, as claimed by Applicants, using any disclosed emulsifiers. Modifying Fischer with the teachings of Parlar, to achieve Applicant's invention as now claimed would result in destroying the intended function of Fischer (wax particles-in-brine emulsions). The result would clearly be formation of a brine-in-wax particles emulsion, which would assuredly destroy the intended function of the Fischer wax particles-in-brine emulsions for pumping into wellbores.

If a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. See In re Fritch, 972 F.2d at 1265 n.12, 23 U.S.P.Q.2d at 1783 n.12 ("A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose."). Further, beyond looking to the prior art to determine if it suggests doing what the inventor has done, one must also consider if the art provides the required expectation of succeeding in that endeavor. See In re Dow Chem. Co., 837 F.2d

at 473, 5 U.S.P.Q.2d at 1531("Both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure."). "Obviousness does not require absolute predictability, but a reasonable expectation of success is necessary." In re Clinton, 527 F.2d 1226, 1228, 188 U.S.P.Q. 365, 367 (C.C.P.A. 1976).

Applicants also take note of EWP Corp. v. Reliance Universal, Inc., 755 F.2d at 907, 225 U.S.P.Q. at 25 ("A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. On the issue of obviousness, the combined teachings of the prior art as a whole must be considered."). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965); see also Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 448-49, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986) (holding that the district court, by failing to consider a prior art reference in its entirety, ignored portions of the reference that led away from obviousness).

Combining the teachings of Parlar et al. with those of Fisher et al., as a whole, would destroy the intended function of Fischer. Further, Fischer provides no reasonable expectation of succeeding in providing a brine-in-oil emulsion. Hence, Applicant submits that the rejection does not have proper basis, by lacking requisite motivation to combine as well as no reasonable expectation of success, and withdrawal of the rejection is thereof is in order. As such, the invention as claimed is non-obvious over the combination of references.

Regarding Examiner's comments regarding previous arguments by Applicant in this pending application, Applicants respectfully traverse these comments and do not concede any position.

Applicants believe the claims are in condition for allowance. If the Examiner believes that the prosecution of the application would be facilitated by a telephone interview, Applicants invite the Examiner to contact the undersigned at 281-285-8606.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 04-1579 (56.0773).

Respectfully submitted,

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